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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,921	07/20/2005	Masanori Ogawa	2710/74696	9558
<div>7590 Donald S. Dowden Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036</div>			<div>EXAMINER KRUER, KEVIN R</div>	
			<div>ART UNIT 1773</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 09/18/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/542,921	OGAWA ET AL.	
	Examiner	Art Unit	
	Kevin R. Kruer	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 2, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/14281 (Hennen).

Hennen teaches a release liner (herein understood to read on the claimed masking member) comprising a thermoplastic elastomer core layer and release coating comprising polypropylene applied to either side thereof (page 3, lines 13+). The TEO of the core comprises 15-85wt% polypropylene and 85-15wt% ethylene propylene rubber (page 5, lines 8+). The TEO may be further blended with 50-95wt% polypropylene (page 8, lines 12+). The amount of rubber is adjusted based upon the desired characteristic of the sheet (page 5, lines 10+). Thus, it would have been obvious to the skilled artisan to optimize the amount of rubber utilized in the core layer. The motivation for doing so would have been to control the rubber qualities of the final laminate.

3. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/14281 (Hennen), as applied to claims 1 and 4 above, and further in view of JP 05154423A (herein referred to as Nagoya).

Hennen is relied upon as above, but does not teach the base layer should comprise filler. However, Nagoya teaches filler may be added to a base layer of a 3 film in amounts of 20-500wt% in order to improve the mechanical and thermal properties of the film (0015). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add filler to the base layer taught in Hennen in amounts sufficient to obtain the desired thermal and mechanical properties

Response to Arguments

Applicant's arguments filed July 2, 2007 have been fully considered but they are not persuasive.

Applicant argues the prior art applied against the claims teaches a masking member which is made by a different method and thus has different properties. Specifically, the claimed masking material is made by vacuum and/or pressure forming. The examiner notes said limitations are a method limitation in a product claim. In order to patentably distinguish the claimed product from the prior art, the method limitation must inherently result in a distinctive structure characteristic. In order to try to meet their burden, applicant argues the claimed invention has a "complex shape." Said argument is noted but is not persuasive because no evidence has been presented to support said conclusion. The examiner maintains the position that the claimed method limitation "being manufactured by vacuum and/or pressure forming" does not require the masking member to have any particular shape. Thus, the film/planar shape taught by the prior art is understood to read on the claimed "prescribed shape" of the claimed

Art Unit: 1773

invention because vacuum and/or pressure forming may be utilized to form a planar sheet.

Applicant further argues the claimed invention exhibits good moldability, good hardness, and dimensional stability. Said argument is noted but is not persuasive because applicant has failed to provide evidence in support of said conclusions. Furthermore, the prior art teaches the addition of filler to the core layer is expected to result in the better moldability, dimensional stability, and hardness (see abstract of Nagoya). Thus, said properties are understood to be latent to the laminate rendered obvious by the prior art.

Applicant further argues Hennen teaches a film like release liner which is not self-supporting and capable of complex shapes. Said argument is noted but is not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., self-supporting laminates and complex shapes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner acknowledges the release sheets of Hennen are not made by molding but notes said limitation patentably distinguishes the claimed film only if there is a showing that the method limitation inherently results in a distinct structural characteristic. As noted above, applicant has failed to meet the burden of establishing such a distinct structural characteristic inherently exists.

Art Unit: 1773

Applicant argues the skilled artisan seeking a composition that provides for excellent moldability and dimensional stability for a molded masking member of complex shape would not seek direction from Hennen. Said argument is noted but is not persuasive because said determination is not central to the question of whether Hennen renders obvious the claimed laminate. Specifically, applicant has failed to identify what claim limitation Hennen fails to anticipate/render obvious. As noted above, the claims are not limited with regards to moldability and dimensional stability.

Applicant argues criticality with respect to the amount of polyethylene and/or ethylene copolymer is mixed with the polypropylene as it relates to moldability and dimensional stability. Said argument is noted but is not persuasive because applicant has failed to provide/explain the evidence that supports said argument of unexpected results.

For the reasons noted above, the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1773

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kevin R. Kruer
Patent Examiner-Art Unit 1773